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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,179	03/02/2004	Jean-Louis H. Gueret	08048.0045-00	3236
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
KARLS, SHAY LYNN				
ART UNIT		PAPER NUMBER		
3723				
MAIL DATE		DELIVERY MODE		
03/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,179

Applicant(s)

GUERET, JEAN-LOUIS H.

Examiner

Shay L. Karls

Art Unit

3723

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 7, 10, 15, 19, 22, 42, 45, 50, 54 and 57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 9, 11-14, 16-18, 20, 21, 23-41, 43, 44, 46-49, 51-56 and 58-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6, 8, 11-12, 14, 16-18, 20-21, 23-41, 43, 46, 48-49, 51-53, 55-56, 58-68 rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (USPN 20020011251).

With regards to claim 1 and 34, Gueret teaches an applicator for applying a cosmetic product comprising an applicator element wherein the applicator comprises a support (151) made from a plastic material (col. 3, lines 14-16). There is at least one bundle of bristles (155) associated with the support. The bundle comprises an end portion defining a first row of bristles (figure 23, bristles extending downward) extending substantially in a longitudinal direction of the support. There are two other bundles extending away from the support (right and left bundles on figure 23). The three bundles define a first, second and third row of bristles extending at least outside the support. The support defines a plurality of openings (153) that the bundles pass through (claim 34).

With regards to claim 2, 35 and 37, the first row of bristles extends at least in part outside of the support (figure 23).

With regards to claim 3 and 38, the first row of bristles comprises a number of bristles that is substantially equal to the number of bristles in the second and third rows.

With regards to claim 4, 36 and 39, the support defines distinct openings (153), wherein the second and third rows of bristles comprise respective succession of tufts exiting the support via the distinct openings (figure 23).

With regards to claim 5 and 40, the first row of bristles comprises a substantially continuous sheet of bristles (the bundle is considered to a sheet since there is no limitation further explaining what a sheet is).

With regards to claim 8 and 43, the second and third rows of bristles extend from one side of the support relative to a separation plane containing a longitudinal axis of the support, and wherein the first row extends from an opposite side of the support relative to the separation plane (the separation plane extends through the crossing of the distinct openings in figure 23).

With regards to claim 11 and 46, the support comprises at least one row of teeth (points of triangle are considered to be teeth).

With regards to claim 12, the row of teeth extends between the second and third rows of bristles (figure 23).

With regards to claim 14, 48 and 49, the second and third rows each comprise tufts of bristles, and wherein the tufts of the second row and the tufts of the third row are disposed at substantially the same level along an axis of the support (figure 23, shows that the length of the bristles are the substantially the same).

With regards to claim 16 and 51, the support defines openings (153) situated respectively in two opposite faces (152) of the support, and wherein the bundles each define at least one tuft exiting the support via the openings.

With regards to claim 17 and 52, the support defines openings (153) situated respectively in the same face (152) of the support (the length of the support has many openings in the same face, see figure 18-19; figure 23 is only a cross section of one of the openings) and wherein the bundles each define at least one tuft of bristles exiting the support via the openings.

With regards to claim 18 and 53, the support has a rectilinear longitudinal axis.

With regards to claim 20 and 55, the apparent length of the bristles of at least one row varies along a longitudinal axis of the support (the length varies due to the flaring caused by opening 154 in figure 23).

With regards to claim 21 and 56, the support defines openings comprising axes perpendicular to a longitudinal axis of the support and wherein the bristles pass through the openings and extend away from the support (the longitudinal axis is a line and therefore all the faces 152 of the support can be considered to perpendicular to the axis).

With regards to claim 23 and 58, the plastic material of the support is a rigid material, semi-rigid material or an elastomer (col. 3, lines 51-54).

With regards to claim 24 and 59, there is further a stem (11), a cap (12) and a receptacle (2). The applicator element is located at one end of the stem and the cap is located at another end of the stem (figure 1).

With regards to claim 25 and 60, the support is fitted to the stem.

With regards to claim 26 and 61, the support and the stem have a one-piece integral construction (figure 1).

With regards to claim 27 and 62, the applicator is configured to apply the product to at least one of eyelashes and eyebrows (col. 5, lines 10-12).

With regards to claim 29 and 64, the support defines a plurality of openings (153) and wherein the bristles of the bundles pass through the openings and extend away from the support.

With regards to claim 30 and 65, there is a cosmetic product being applied via the applicator (col. 4, lines 65-67).

With regards to claim 31 and 66, the cosmetic product is a product for the eyelashes (col. 4, lines 65-67).

With regards to claim 32 and 67, there is further a receptacle (2) to contain the cosmetic product.

With regards to claim 33 and 68, there is further a wiper (5) associated with the receptacle.

Gueret teaches all the essential elements of the claimed invention however fails to teach that the three fiber bundles as shown in figure 23 is a single fiber bundle split among the three holes (claim 1, 6, 28, 34, 41 and 63). Figures 12 and 26 clearly show having a single bristle bundle extending through the entire support, which means that the support is capable of supporting one single bundle. It would have been obvious to one of ordinary skill in the art to modify the fiber bundles of figure 23 so that there is not three of them, but instead one fiber bundle divided among three holes. Figure 26 shows a single fiber bundle passing through a first hole to a second hole wherein the first hole and the second hole are not in longitudinal alignment. Thus, one of skill in the art would have recognized the ability to pass a bundle of fibers through three holes that were not in longitudinal alignment as shown by figure 23. Further, there is nothing preventing a single fiber bundle from being used. The structure of the support is the same for both a single fiber bundle or three separate fiber bundles, thus it would have been equally obvious to use a single fiber bundle or

three fiber bundles to achieve the same final product. Using a single fiber bundle instead of three fiber bundles would cut down on production costs since less material is necessary.

Claims 13 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret ('251).

Gueret teaches all the essential elements of the claimed invention as stated above however fails to teach that the major dimension of the support in a plane perpendicular to a longitudinal axis of the support is less than or equal to 5mm. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the major dimension of Gueret so that it is less than or equal to 5mm since the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device. Therefore, the claimed device was not patentably distinct from the prior art device. Further one of skill in the art would by routine experimentation determine the optimum size of the major dimension of the support to optimize the performance of the brush. MPEP 2144.

Claims 9 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret ('251).

Gueret teaches all the essential elements of the claimed invention as stated above however fails to teach that the bristles are held to the support by overmolding the plastic on the bristles. The bristles of Gueret are secured by friction fit however the final end product is essentially the same as the present invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the process used to secure the bristles to the support so that overmolding is the process used to make the product. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113. Given that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

Response to Arguments

The applicant was correct in stating the Gueret 7156105 is an improper 102(b). The Examiner intended to use the PGPub of that reference and did so in the new rejection above. The Examiner has used the PGPub reference to Gueret as an obvious type rejection indicating that it is within the level of skill in the art to modify the reference so that only a single bundle of fibers is used rather than the disclosed three bundles. The applicant further argues that the Examiner failed to cite any support as to why it would have been obvious to modify the reference using overmolding. In response, the claim is considered to be a product-by-process claim and even though the claims are limited by and defined by the process, determination of the patentability is based on the product itself. As stated above, the patentability of a product does not depend on the method of production. Thus since the claimed product appears to be the same or similar to that of the Gueret reference, although produced by a different process, the burden shifts to the applicant to provide evidence establishing an unobvious difference between the claim and the prior art. Therefore the rejection to claims 9 and 44 are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shay L. Karls whose telephone number is 571-272-1268. The examiner can normally be reached on 7:00-4:30 M-Th, alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shay L Karls/
Primary Examiner, Art Unit 3723